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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,078	10/06/2000	David Allison Bennett	PSTM0010/MRK/STM	3150

29524 7590 05/21/2007  
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EXAMINER
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PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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05/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/685,078	BENNETT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Jamisue A. Plucinski	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 February 2007.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-6,28-33,49-52 and 58-65 is/are pending in the application.

4a) Of the above claim(s) 59-65 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-6,28-33,49-52 and 58 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-6, 28-33, 49-52, 58-65 are pending.
2. Claims 59-65 are withdrawn from consideration.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 1-6, 49-52 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al (5,485,369) in view of Fisher et al. (6,047,264), Kara et al. (6,233,568) and Thiel (5,699,258).
6. With respect to Claims 1, 4, 6, 49-50, 52, and 58: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to perform rate calculations

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(column 4, lines 8-24). Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).

7. Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to disclose the specific delivery requirements includes an electronic mail delivery notification. Fisher discloses a method for supplying automatic status updates using e-mail (See abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher, in order to automatically send delivery status messages over e-mail without the aid or need of a human customer service representative. (See Fisher, columns 1 and 2).

8. Fisher and Nichols discloses a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose determining whether a carrier would provide a specific service (such as proof of delivery which is shown by Nicholls and Fisher), and simultaneously displaying the rates of the carriers to the user. Kara discloses a computer program used for multiple shippers that determines if a carrier provides a specific service (Column 22, lines 13-48) and simultaneously displays rates for multiple carriers and calculate shipping rates of multiple services for multiple carriers (first, second, third and fourth) (See

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Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22)

9. Nicholls, Fisher and Kara, disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of the rates for each carrier for each service. Thiel discloses the use of a system for calculating rates for multiple carriers for multiple services (see abstract), and discloses the computer storing data for the rates of each service for each carrier in one table (Column 11, lines 1-13). Thiel also discloses that the system will walk the user through which service is wanted, however discloses displaying only the final rate for desired service for multiple carriers (Column 11, lines 46-54).

10. Nicholls, Kara and Theil fail to disclose the “simultaneous” display of shipping charges for each service of each carrier. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to display all charges simultaneously. All the rates of each service of each carrier are calculated by Nicholls, Kara and Thiel. Thiel even shows all the rates are stored in one table, however, they all require some sort of selection by the user before each charge is displayed. The way something is displayed, is not considered to be patentable over the prior art of record, therefore it would have been obvious for one of ordinary skill in the art to display all the calculated rates simultaneously for comparison purposes. It should also be noted that the claims are all drawn to system claims, which are limited to the actual systems and their capabilities, and that what information is actually displayed is considered to be printed

matter, and unless the information is used further in the system, then what is actually displayed is considered non-functional.

11. With respect to Claims 2, and 29: See Nicholls, Figure 4A.
12. With respect to Claims 3 and 30: See Nicholls, Column 7, lines 53-67.
13. With respect to Claims 5 and 32: Nicholls discloses displaying a rate adjustment for the special service fees (See Figure 4D).
14. Claims 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al (5,485,369) in view of Pauley et al. (4,958,280), Kara et al. (6,233,568), and Thiel (5,699,258).
15. With respect to Claims 28, 31, and 33: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to perform rate calculations (column 4, lines 8-24). Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).
16. Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to specifically disclose the proof of delivery is a verbal delivery notification. Pauley discloses the use of costumer service representatives which provide verbal communication of delivery status (Column 9, lines 34-38). It would have

been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the notification by the customer service representative, as disclosed by Pauley, in order to allow users to obtain delivery information without the use of a computer. See Pauley columns 2 and 4).

17. Nicholls and Pauley disclose a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose displaying the rates of the carriers to the user and determining which carriers provided a selected service. Kara discloses a computer program used for multiple shippers that determines which carriers can provide a selected service (Column 22, lines 13-48) and displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22)

18. Nicholls, Pauley and Kara, disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of the rates for each carrier for each service. Thiel discloses the use of a system for calculating rates for multiple carriers for multiple services (see abstract), and discloses a simultaneous display of rates for each carrier, that includes rates for different services (Column 11, lines 1-13). Thiel discloses displaying rates for the preferred carrier, but also discloses displaying the rates for second and third choices as well (Column 11, lines 46-54). It would have been obvious to one having

ordinary skill in the art at the time the invention was made to modify Nicholls, Pauley and Kara, to simultaneously display the rates of each carrier for each service, in order to allow the customer to come to his/her own conclusion and choice of carriers. (See Theil column 11).

19. With respect to Claim 29: See Nicholls, Figure 4A.
20. With respect to Claim 30: See Nicholls, Column 7, lines 53-67.
21. With respect to Claim 32: Nicholls discloses displaying a rate adjustment for the special service fees (See Figure 4D).

***Response to Arguments***

22. Applicant's arguments filed 2/21/07 have been fully considered but they are not persuasive.
23. With respect to Applicant's argument that the asserted combination of Fisher with Nicholls is not supported: The applicant has stated that the claim has been amended to disclose determining if a carrier provides electronic delivery mail notification. This added claim limitation is addressed in the rejection above. It is the examiners position that if a carrier does not provide a service, then it cannot calculate a rate for that service, therefore the calculation in Nicholls cannot be done. However, Kara shows this step being actively discussed on determining if a carrier provides a selected service, or could meet shipping parameters. The rejection above has been amended to show this claim limitation. The applicant has stated that Nicholls "specific delivery requirements" do not equate to the claim which recites "a request input by a user for an electronic mail delivery notification service by a carrier..." However

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Nicholls discloses a Proof of Delivery option, which is used to calculate a rate. Fisher discloses the use of a proof of delivery being in electronic form. Therefore the examiner considers the combination of Nicholls and Fisher to disclose this claim limitation. The applicant has also stated that the claim limitation does not disclose electronic updates of status, but rather discloses electronic delivery notification. However the status of delivered which is sent to the user, is a delivery notification, and due to the fact that it is sent over e-mail, then the examiner considers this to be an electronic delivery notification. The applicant has argued that there is no disclosure in Fisher that the carriers themselves provide delivery notification, but that the system of Fisher retrieves information from the carrier system and forwards this to the customer. However the limitation of proof of delivery sent by the carrier is taught by Nicholls, Fisher is merely used to show a form of proof of delivery is electronic. Therefore, as combined, the examiner considers there to be sufficient motivation to combine Nicholls and Fisher and the combination along with Kara teaches the claimed limitation. The examiner considers the recited combination, to teach the claimed limitations, and rejections stand as stated above.

24. With respect to Applicant's argument that there is no disclosure in Fisher of the carriers themselves providing delivery notification or of any monetary distinction or service level distinction...: Whereas Fisher may not disclose the entirety of the claim, the combination of references do. Fisher is merely used to show that delivery notification can be in the form of electronic delivery confirmation. Fisher is not relied on to show the carriers themselves providing the delivery notification or of any rates or service level distinctions. Fisher is relied on solely to show the use of a proof of delivery can be electronic.

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25. With respect to Applicant's argument that there is no disclosure in Pauley of the carriers themselves providing delivery notification or of any monetary distinction or service level distinction...: Whereas Pauley may not disclose the entirety of the claim, the combination of references do. Pauley is merely used to show that delivery notification can be in the form of verbal delivery confirmation. Pauley is not relied on to show the carriers themselves providing the delivery notification or of any rates or service level distinctions. Pauley is relied on solely to show the use of a proof of delivery can be electronic.

26. With respect to Applicant's argument Nicholls, Kara and Theil do not disclose the simultaneous display of the charge for each service for each carrier and that the asserted obviousness is not supported by evidence but rather is based on use of the present invention as a roadmap to combine disparate features of separate references: The applicant argues that the office action states that Kara does not disclose the simultaneous display of multiple services for multiple carriers. Kara calculates rates for multiple services for multiple carriers, however simultaneously displays rates for multiple carriers for a selected service. As stated in the office action, Kara discloses simultaneous displaying of rates for multiple carriers for a selected service. And is fully capable of calculating rates for multiple services for multiple carriers, however is not done simultaneously. Theil discloses the rates using the tables are calculated simultaneously, however the output to the user is only the final rate for the selected service. As stated in the office action the way something is displayed, whether it be simultaneous or by a user interaction of clicking check mark boxes in a screen is not considered to be patentable of the prior art of record. The claims are drawn to system claims. In the system of Nicholls, Kara and Theil the calculation of all the rates are done, and displayed, so if the content of the display is not

used further in the claim, then what is actually displayed is descriptive material. Applicant's arguments are not considered to be persuasive and rejection stands as stated above.

***Conclusion***

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jamisue Plucinski  
Patent Examiner  
Art Unit 3629